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OFFICE OF PETITIONS

In re Application of
Hajime Saito, et al.
Application No. 10/660,472
Filed: September 11, 2003
Attorney Docket No. 09867/0200009-US0

ON PETITION

This is in response to the petition under 37 CFR 1.47(a), filed December 19, 2003.

The petition is dismissed.

Rule 47 applicant is given TWO MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(a)," and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor. **FAILURE TO RESPOND WILL RESULT IN ABANDONMENT OF THE APPLICATION.** Any extensions of time will be governed by 37 CFR 1.136(a).

A grantable petition under 37 CFR 1.47(a) requires: (1) proof that the non-signing inventor cannot be reached or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings); (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116; (3) the petition fee; and (4) a statement of the last known address of the non-signing inventor. Applicant lacks items (1) set forth above.

As to item (1), the applicable statute (35 USC 116) requires that a "diligent effort" have been expended in attempting to find or reach the nonsigning inventor. See MPEP 409.03(a). The showing currently fails to demonstrate, with a documented showing, that a diligent effort was made to find or locate inventor Takao Tada, such that the declaration can be accepted under 37 CFR 1.47(a).

Where inability to find or locate a named inventor(s) is alleged, a statement of facts should be submitted that fully describes the exact facts which are relied on to establish that a *diligent effort* was made to locate the inventor. The statement(s) of fact must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay, will not normally be accepted.

The petition indicates that Mr. Tada was employed by Assignee of the Konami Corporation. Mr. Tada retired from his employment as of July 30, 2003 and presently his whereabouts cannot be determined. Since petitioner has access to inventor Tada's employee records, petitioner should indicate what an inspection of the records reveals as to a current address, forwarding address, or an address of the nearest living relative. What does inspection of the phone directories for those address locations reveal? Did any

of Mr. Tada's co-workers keep in touch with him? At the very least, a search should be made of the telephone directories of the greater Japan area, and any regional or national registry(s). Copies of the results of the search must be referred to in any renewed petition. See MPEP 409.03(d). If inventor Tada is located, then a complete copy of the application papers (specification, claims, drawings, drawings, oath, etc.) should be mailed to Mr. Tada's address, return receipt requested, along with a cover letter of instructions which includes a deadline or a statement that no response will constitute a refusal. This sort of ultimatum lends support to a finding of refusal by conduct. If the papers are returned and all other attempts to locate or reach the inventor, e.g., through personnel records, co-workers, E-mail, the Internet or the telephone, etc., continue to fail, then applicant will have established that the inventor cannot be reached or has refused to join in the application. The statements of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein.

If the inventor is located and the inventor orally refuses to join in the application after having been presented with a copy of the application papers (specification, claims, drawings), that fact along with the time and place of the refusal must be stated in the affidavit or declaration. If, on the other hand, petitioner receives an express written refusal, a copy of the document evidencing that refusal must be made part of the affidavit or declaration.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop PETITION
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Telephone inquiries related to this decision should be directed to Irvin Dingle at (703) 306-5684.



Frances Hicks
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Office of the Deputy Commissioner
for Patent Examination Policy